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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,647	02/06/2002	Timothy Tianyi Chen	0264-1	3268
25901	7590	10/17/2007		
ERNEST D. BUFF ERNEST D. BUFF AND ASSOCIATES, LLC. 231 SOMERVILLE ROAD BEDMINSTER, NJ 07921			EXAMINER CARLSON, JEFFREY D	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 10/17/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/072,647	<b>Applicant(s)</b> CHEN, TIMOTHY TIANYI	
	<b>Examiner</b> Jeffrey D. Carlson	<b>Art Unit</b> 3622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 July 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 9-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 9-13 are system (apparatus) claims, yet they include features which are presented as apparent method steps rather than capabilities, rendering the claim scope uncertain. In these computer-based system claims, the best way to set forth apparatus structure is to claim *capabilities* of the apparatus by stating an element/module/subsystem is *programmed to <perform an act>* OR is *configured to <perform an act>*, rather than claiming the element actively performs the act.
  - For example, claim 9 sets forth cards "appointed to be distributed", yet it is unclear what structure is present capable of accomplishing either an step of appointing or a step of distributing.
  - Claim 10, it is unclear what structure is responsible for the apparent step of message *generating in accordance with* target criteria.

- Claim 13, the correlator should be configured to generate effectiveness data rather than claiming the actual step of “correlator generates”.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 9-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

- Claims 9-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These system (apparatus) claims appear to include human beings – a retailer and a respondent each connected to the system apparatus. The system apparatus is merely configured to communicate with systems of the retailer and respondent.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 103 that form the basis for the rejections under this section made in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**6. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over van der Riet (US7158943) in view of Hohle et al (US20020046116).**

Van der Riet enjoys the benefit of earlier filed provisional application 60/316268. Regarding claims 1-4, 11-13, van der Riet teaches a system that stores user profiles, presents retailers' advertising targeted to users based on their profiles, provides loyalty cards to users for enabling their online and offline shopping to be tracked after exposure to an advertisement, and calculates advertising effectiveness for the retailers according to ad exposure and associated purchasing [abstract, columns 5-6]. 60/316268 by van der Riet does not appear to teach a loyalty card per se. van der Riet does however teach identification of consumers and tracking of their purchase histories and behaviors (holistic consumer profiles) and delivery of targeted advertising to them according to those identified/matched profiles [pg 5 – "key ideas" of 60/316268]. Consumers are rewarded for the use of their holistic profiles by personalized ad-based information – "best compared with that of an activity based loyalty point system" [pg 6 #13, pg 9, #9 of 60/316268]. While van der Riet teaches what amounts to loyalty profiles and a loyalty system, there is no apparent mention of a loyalty identification card. Hohle et al teaches the use of identification/loyalty cards for online and offline purchasing in a loyalty system [0027]. It would have been obvious to one of ordinary skill at the time of the invention to have used any type of identification card including those described by Hohle et al so that the unique consumer profiles of van der Riet can be uniquely associated and tracked as desired.

Regarding claim 5, it is inherent that the on-going operation of van der Riet includes repeated targeting of effective ads.

Regarding claims 6, 14, the ability to measure the effectiveness for an ad in association with purchase data is taken to include at least capture of the item purchased in the consumer transactions.

Regarding claims 9, 10, the system of van der Riet is capable of serving many different retailers and is taken to be an third party/administrator system. The ads are stored in ad database in association with retailer-defined criteria [13:27-29].

Regarding claims 7, 8, van der Riet teaches that targeted advertising can be sent to the consumers anywhere, anytime via their PC [15:15-16], yet van der Riet does not appear to mention the use of email. Official Notice is taken that it is well known for online shopping/advertising systems to include capture of user's email addresses upon registration so that advertising and offers can be sent to the user via email. It would have been obvious to one of ordinary skill at the time of the invention to have communicated the targeted advertising of van der Riet to users using email, as this is a cheap and efficient means of delivering text/image-based advertising and offers.


Regarding claim 15, Hohle et al teaches that the identification card technology may include barcode technology [0028]. Further, Official Notice is taken that magnetic stripe cards and as well as uniquely-assigned drivers licenses are typically used as loyalty cards and it would have been obvious to one of ordinary skill at the time of the invention to have provided either as a means of identifying the consumer.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622

jdc